No. 14800

United States
Court of Appeals
for the Ninth Circuit

FRANCES P. SYRACUSE and NEW WONDER BAG CORPORATION,

Appellants,

vs.

HARRY PARIS,

Appellee.

Transcript of Record

Appeal from the United States District Court for the Southern District of California, Central Division.

Phillips & Van Orden Co., 870 Brannan Street, San Francisco, Calif.—9-30-55

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[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in italic; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in italic the two words between which the omission seems to occur.]

NAMES AND ADDRESSES OF ATTORNEYS

Attorney for Appellant:

ALAN FRANKLIN,
356 South Spring Street,
Los Angeles 13, California.

Attorney for Appellee:

WARNER, PERACCA & COWAN,
215 West Seventh Street,
Los Angeles 14, California;

C. G. STRATTON,
210 West Seventh Street,
Los Angeles 14, California.

In the United States District Court Southern District of California, Central Division

No. 15994—T

FRANCES P. SYRACUSE and NEW WONDER BAG CORP.,

Plaintiffs,

vs.

HARRY PARIS, DOE I, DOE II, DOE III, DOE IV,

Defendants.

COMPLAINT FOR PATENT INFRINGEMENT

Comes Now the Plaintiffs and for their cause of action against the defendants and each of them alleges:

I.

This cause of action arises out of the patent laws of the United States of America, U. S. C. Title 35 as amended, as hereinafter more fully appears.

II.

On December 12, 1950, U. S. Letters Patent No. 2,533,850 were duly and legally issued to plaintiff, Frances P. Syracuse, for an invention in "Utility Handbags Having Double Compartments with Individual Closures and Independently Accessive Bottle Pockets," and since that date plaintiff, Frances P. Syracuse, has been the owner of said

U. S. Letters Patent No. 2,533,850 up to the date of January 5, 1951, when said patent was assigned [2*] to plaintiff, New Wonder Bag Corp., which corporation is still the owner of said patent.

III.

Defendants have been and still are wilfully, deliberately and intentionally infringing said Letters Patent by making, using and selling utility handbags embodying the patented invention, and will continue to do so unless enjoined by this court.

IV.

Plaintiffs have given written notice to the defendants of their said infringement, and have duly complied with the statutes respecting patent notice.

V.

The true names and/or capacities of the defendants, Doe I, Doe II, Doe III, and Doe IV, are unknown to the plaintiffs, who therefore sue said defendants by such fictitious names, and ask leave to amend to show their true names and/or capacities, whether individual, corporate, or otherwise, when the same have been ascertained.

Wherefore, plaintiffs demand a preliminary and final injunction against further infringement by defendants and those controlled by defendants, an assessment of costs and attorneys' fees against the defendants and an accounting for profits and damages, and that said profits and damages be tripled on ac-

*Page numbering appearing at foot of page of original Certified Transcript of Record.

count of the deliberate, wilful and intentional nature of the defendants' infringement.

HAROLD SHIRE and
ROBERT E. GEAUQUE,

By /s/ ROBERT E. GEAUQUE,
Attorneys for Plaintiffs.

[Endorsed]: Filed October 29, 1953. [3]

[Title of District Court and Cause.]

AMENDED ANSWER

Comes now the defendant Harry Paris, hereinafter called said defendant, and answering for himself alone, admits denies and alleges as follows:

I.

Answering paragraph II of the Complaint filed herein, said defendant admits that on or about December 12, 1950, U.S. Letters Patent No. 2,533,850 were issued to plaintiff, Frances P. Syracuse, on a "Utility Handbag Having Double Compartment [5] with Individual Closures and Independently Accessible Bottle Pockets," but denies that such patent was duly or legally issued, and denies that said Handbag involves invention. As to the truth of the remaining averments of paragraph II of said Complaint, said defendant is without knowledge or information sufficient to form a belief.

II.

Answering paragraph III of said Complaint, said defendant denies generally and specifically each and every allegation therein contained.

III.

Answering paragraph IV of said Complaint, said defendant denies that he received from plaintiffs a written notice of defendant's alleged infringement, but as to the other averments of said paragraph IV, said defendant is without knowledge or information sufficient to form a belief.

Further Answering Said Complaint, and for Separate, Alternate and Further Defenses, the Said Defendant Alleges and Denies as Follows:

IV.

Denies that the device shown, described and claimed in the Letters Patent in suit, embodies any material or patentable advance over what was previously known to others skilled in the art, but on the contrary alleges that the claim of said patent is invalid and void because the alleged improvements described and claimed therein, and all material and substantial parts thereof, have been, prior to the date of the alleged invention or discovery thereof by the plaintiff Syracuse, [6] described, published, patented or claimed in the following U. S. Letters Patent:

Johnston ..... 312,355—Feb. 17, 1885
Izett .....1,136,138—Apr. 20, 1915

Nover .....1,235,049—July 31, 1917
Penny .....1,352,372—Dec. 16, 1919
Diamond .....1,397,369—Nov. 15, 1921
Sommer .....Des.61,668—Nov. 14, 1922
Gale .....1,617,629—Feb. 15, 1927
Zichy .....1,653,246—Dec. 20, 1927
Struble .....1,902,313—Mar. 21, 1933
Halpin .....2,025,101—Dec. 24, 1935
Wehner .....2,029,686—Feb. 4, 1936
Lyndes, et al. .....2,274,718—Mar. 3, 1942
Broudy .....2,369,943—Feb. 20, 1945
Salem .....2,394,332—Feb. 5, 1946
Vasquez .....2,429,856—Oct. 28, 1947
Holland .....2,447,940—Aug. 24, 1948

V.

Alleges that the patent in suit is void and of no effect in law, in that devices containing the alleged improvements were invented by, known, on sale, and in public use in the United States before the conception of, and before the reduction to practice by the plaintiff Syracuse of the purported invention of the patent in suit, by the above-named patentees and by the parties listed hereinafter, whose places of invention, knowledge, sales and public use are respectively the residences of the patentees given in the above patents and the places listed after the respective names in the following list; and that said alleged improvements were invented by, known, on sale and in public use in the United States for more [7] than one (1) year prior to the application

for the patent in suit, by the patentees listed hereinbefore and by the parties listed hereinafter, whose places of invention, knowledge, sale and public use are respectively the residences given in the foregoing listed patents and the places listed after the following names respectively:

Harry Paris,
Los Angeles, California;

Sears, Roebuck & Co.,
Los Angeles, California;

Consolidated Bag Co.,
Los Angeles, California;

California Cobblers,
Los Angeles, California.

VI.

Alleges that while the application for the patent in suit was pending in the United States Patent Office, the plaintiff Syracuse, though her attorney, so limited and confined the claim of the patent in suit, under the requirements of the Commissioner of Patents, that the plaintiffs herein cannot now seek or obtain interpretation of said claim sufficiently broad to cover any device made, used, or sold by the said defendant Paris.

VII.

Alleges that the art in connection with the device shown in said Letters Patent in suit was crowded prior to the alleged invention or discovery

thereof by plaintiff Syracuse; and that the conception of the alleged invention or discovery required no invention whatever, but only ordinary mechanical skill, and that as a consequence the claim in suit fails to embody or [8] disclose any patentable invention which was not already common knowledge in the art, and that such claim, therefore, is void for lack of invention.

VIII.

Alleges that the claim in suit does not cover any valid or patentable combination, but embraces a mere aggregation of elements which have no definite and proper combination or co-operation, and that, therefore, the claim in suit fails to cover patentable subject matter and is, therefore, void.

IX.

Alleges that the patent in suit has been generally disregarded and ignored by the public and that the plaintiffs, well knowing of these actions by the public, have acquiesced in the general disregard of such patent; and that the said defendant has relied upon such acquiescence by the plaintiffs, whereby the plaintiffs are estopped from enforcing any alleged claim of infringement against said defendant.

X.

Alleges that the claim in suit is ambiguous, indefinite and uncertain, and does not particularly point out the part, improvement or combination which the plaintiff Syracuse claimed as her alleged

invention, as required by the Patent Statutes of the United States.

Wherefore, said defendant Harry Paris prays that plaintiffs' Complaint be dismissed; that Judgment be entered in favor of said defendant; that said defendant be awarded his costs of suit herein; and for such other and further relief [9] as to the Court seems just and equitable.

WARNER, PERACCA & COWAN,

C. G. STRATTON,

By /s/ C. G. STRATTON,
Attorneys for Defendant
Harry Paris.

[Endorsed]: Filed April 1, 1954. [10]

[Title of District Court and Cause.]

MOTION FOR SUMMARY JUDGMENT

Defendant Harry Paris moves the Court to enter, pursuant to Rule 56 of the Federal Rules of Civil Procedure, a Summary Judgment in said defendant's favor, dismissing the action on the ground that United States Letters Patent in suit, No. 2,533,850, and the only claim thereof, are invalid.

The grounds for this Motion are:

(1) The combination claimed by the patent in suit is clearly anticipated by prior patent art which

was not cited or considered by the Commissioner of Patents while the application [11] for the patent in suit was pending and being prosecuted before the United States Patent Office;

(2) The combination claimed by the patent in suit is devoid of patentable novelty;

(3) There does not exist any genuine issue as to material facts necessary to consideration and determination of this Motion, since invalidity of the patent in suit is clearly apparent from a comparison of said patent in suit with said prior patents which were not considered by the Patent Office, but which are before the Court in this Motion.

In support of this Motion, the defendant Harry Paris will rely upon Rule 56 of the Federal Rules of Civil Procedure, the Affidavit and exhibits filed therewith, the deposition of the plaintiff Syracuse, and upon the annexed Brief in Support of Motion for Summary Judgment.

Dated at Los Angeles, California, this 2nd day of September, 1954.

WARNER, PRACCA & COWAN,
HENRY N. COWAN,
C. G. STRATTON,

By /s/ C. G. STRATTON,
Attorneys for Defendant
Harry Paris. [12]

[Title of District Court and Cause.]

AFFIDAVIT OF C. G. STRATTON

State of California,
County of Los Angeles—ss.

C. G. Stratton, being first duly sworn, deposes and says:

I am of counsel for Harry Paris, defendant herein, and as such counsel prepared and am familiar with the Motion for Summary Judgment herein.

I have obtained from the United States Patent Office, and file herewith as Exhibit "A," a true, certified, copy of [13] the United States Patent Office file wrapper of the United States Letters Patent in suit, No. 2,533,850, which is the patent in suit. The following patents, copies of which are filed herewith as Exhibit "B," were cited by the Examiner during the prosecution of the patent in suit through the Patent Office:

Number, Patentee and Date.

1,136,138 ..... Izett—Apr. 20, 1915
1,325,372 ..... Penny—Dec. 16, 1919
1,653,246 ..... Zichy—Dec. 20, 1927
1,902,313 ..... Struble—Mar. 21, 1933
2,029,686 ..... Wehner—Feb. 4, 1936
2,274,718 ..... Lyndes, et al.—Mar. 3, 1942
2,447,940 ..... Holland—Aug. 24, 1948

I have also caused an independent search to be made of the prior patent art relating to the subject

matter of said patent in suit, in the United States Patent Office, and as a result of said search found the following prior patents, copies of which are filed herewith as Exhibit "C," which were not cited by the United States Patent Office against the application for said Letters Patent in suit:

Number, Patentee and Date.

147,477 (Des.) .....Shanzer—Sept. 9, 1947
312,355 .....Johnston—Feb. 17, 1885
1,235,049 .....Nover—July 31, 1917
1,397,369 .....Diamond—Nov. 15, 1921
61,668 (Des.) .....Sommer—Nov. 14, 1922
1,617,629 .....Gale—Feb. 15, 1927
2,025,101 .....Halpin—Dec. 24, 1935
2,369,943 .....Broudy—Feb. 20, 1945
2,394,332 .....Salem—Feb. 5, 1946
2,429,856 .....Vasquez—Oct. 28, 1947

With the exception of the design patent to Shanzer, the patents listed above were previously listed on page 3 of the Amended Answer in this action.

/s/ C. G. STRATTON.

Subscribed and sworn to before me this 2nd day of September, 1954,

[Seal] /s/ VESTA NELSON,
Notary Public in and for the County of Los Angeles, State of California.
My Commission expires 11/9/56.

Receipt of Copy acknowledged.
[Endorsed]: Filed September 3, 1954. [15]

[Title of District Court and Cause.]

FINDINGS OF FACT AND CONCLUSIONS OF LAW

The Motion of defendant Harry Paris for Summary Judgment having been heard, the Court, being fully advised, makes the following Findings of Fact and Conclusions of Law:

Findings of Fact

(1) The plaintiffs in this action are Frances P. Syracuse and New Wonder Bag Corp. Frances P. Syracuse is a [40] citizen of the United States and a resident of the County of Los Angeles, State of California. New Wonder Bag Corp., is a California corporation having its principal place of business in the County of Los Angeles, State of California, within the Southern District of California, Central Division.

(2) Defendant Harry Paris is a citizen of the United States and a resident of the County of Los Angeles, State of California, and has a regular and established place of business in the City of Los Angeles, County of Los Angeles, State of California, within the Southern District of California, Central Division.

(3) This action arises under the Patent Laws of the United States, set forth in 35 U.S.C., so that this Court has jurisdiction of the parties and of the subject matter of this action.

(4) United States patent in suit No. 2,533,850 was issued by the Commissioner of Patents of the United States on December 12, 1950, to one of the plaintiffs in this suit, to wit, Frances P. Syracuse, the patentee named in said patent, who, on or about January 5, 1951, assigned said patent to New Wonder Bag Corp., a co-plaintiff in this suit.

(5) United States Letters Patent in suit No. 2,533,850 relates to a utility handbag having a double central compartment with individual closures and two side compartments suitable for holding baby milk bottles. Its stated object is to provide a new and useful handbag having separate moisture-proof compartments, one of which is adapted to receive fresh diapers or other clothing, another being for damp or soiled diapers. End pockets are provided to hold bottles (baby milk bottles) or other equipment. The utility bag has two zippers on top for independent access to the two central or diaper compartments and a zipper on each side of the bag for opening and closing the milk bottle [41] compartments.

(6) The application for patent, Serial No. 773,-747, filed September 13, 1947, which matured into the patent in suit, originally contained five original claims. All of the original claims were cancelled in view of the cited art and a single specific claim was submitted by an amendment. This single claim was allowed and now appears as the only claim in the patent in suit.

(7) The patentability was predicated, according to the Patent Office file wrapper history of this patent, on a combination of two central compartments for fresh and soiled diapers, separated by a waterproof partition panel, and two waterproof end pockets for baby milk bottles, with slide fasteners providing individual access to these respective compartments and pockets.

(8) The Commissioner of Patents failed to cite against the application for the patent in suit the most pertinent prior art, including the following prior United States Letters Patent:

Shanzer, Des. Pat. No. 147,477,

which describes and shows the combination claimed in the patent in suit and shows said combination to be old. This Shanzer patent discloses a combined bottle and diaper utility bag having a single diaper compartment accessible from the top, end pockets and slide fasteners providing individual access to these respective compartment and pockets. Providing two top zippers and two top, side-by-side compartments would not be invention and would not involve any more than mechanical skill.

(9) The prior patents to Halpin, 2,025,101; Gale, 1,617,629; Vasquez, 2,429,856; and Nover, 1,235,049, were not cited by the Examiner during the prosecution of the application for the patent in suit through the Patent Office. The said Halpin patent shows two top zippers that lead to two side-by-side [42] top pockets. One of said pockets is waterproof for

receiving a wet bathing suit. Gale suggests that a waterproof pocket may be used for soiled diapers. Vasquez also shows side-by-side zippers leading to side-by-side pockets. Nover teaches side-by-side fasteners (before the days of zippers) leading to side-by-side, top compartments.

(10) The patent in suit does not disclose any patentable combination of elements, does not produce any novel results, and does not perform any new functions over the earlier Design Patent, No. 147,477, to M. Shanzer. The patent in suit does not disclose invention.

(11) Plaintiffs' patent is a combination patent and must be strictly construed.

(12) The device described in plaintiffs' patent does not represent discovery or patentable invention within the meaning of patent law.

(13) Plaintiffs' device was fully anticipated by the prior art and represents only the skill of a mechanic.

(14) The patent in suit and the only claim in said patent are devoid of any patentable novelty and, therefore, invalid.

Conclusions of Law

(1) There is no genuine issue as to any material fact necessary to the consideration and determination of said Motion for Summary Judgment.

(2) The patent in suit and its claim are invalid and void.

(3) The defendant Harry Paris is entitled to judgment declaring United States Letters Patent in suit, No. 2,533,850, invalid and void.

(4) Defendant Harry Paris is entitled to a judgment [43] dismissing the Complaint herein and may recover Court costs.

Dated at Los Angeles, California, this 22nd day of October, 1954.

/s/ ERNEST A. TOLIN,
Judge of the United States
District Court.

[Endorsed]: Filed October 22, 1954. [44]

[Title of District Court and Cause.]

AFFIDAVIT

State of California,
County of Los Angeles—ss.

Alan Franklin, being duly sworn, deposes and says: I am the attorney for the plaintiffs in the above-entitled action, and I am the owner of a handbag shown in the annexed photograph thereof, marked Plaintiffs' Exhibit X. Said handbag was given to me as a Christmas present, not later than a few days before Christmas, 1936, by my friend J. Calvin Brown, Attorney at Law, in the City and County of Los Angeles, California, and said hand-

Exhibit X

bag has been continuously in my possession since the time I received it during the year 1936 as aforesaid, and during said time I have used said handbag considerably for carrying my law books and other articles. I can fix the date when I received said handbag from Mr. Brown, as Christmas 1936, by the fact that I argued the appeal of the case of Bray, et al., vs. Hofco Pump Co., [55] Ltd., 93 F. (2d) 804, before the United States Court of Appeals in San Francisco, California, where I met Mr. Brown at the time near the end of the year 1937, who argued another case at that time before said Court of Appeals, and when I met Mr. Brown in San Francisco as aforesaid he noticed that I was carrying my handbag Exhibit X attached hereto. Said case, Bray, et al., vs. Hofco Pump Co., Ltd., supra was decided the following January 10, 1938.

/s/ ALAN FRANKLIN.

Subscribed and sworn to before me this 17th day of December, 1954.

[Seal] /s/ EUGENE N. FRANKENBERGER,

Notary Public in and for the County of Los Angeles, State of California. [56]

[Title of District Court and Cause.]

AFFIDAVIT

State of California
County of Los Angeles—ss.

I, J. Calvin Brown, being duly sworn deposes and says: That he has read the foregoing affidavit of Alan Franklin, concerning a handbag, Exhibit X, which affiant gave Mr. Franklin as a Christmas gift in 1936, and that the statement of Alan Franklin in respect to said gift in 1936 is true and correct.

/s/ J. CALVIN BROWN.

Subscribed and sworn to before me this 17 day of December, 1954.

[Seal] /s/ EUGENE N. FRANKENBERGER,
Notary Public in and for the County of Los Angeles, State of California. [58]

In the United States District Court, Southern District of California, Central Division

No. 15,994-T

FRANCES P. SYRACUSE; and NEW WONDER BAG CORP.,

Plaintiffs,

vs.

HARRY PARIS; DOE I; et al.,

Defendants.

SUMMARY JUDGMENT

A Motion having been regularly made by the defendant Harry Paris for Summary Judgment in said defendant's favor, dismissing the present action,

Now this Court, on considering the affidavit, exhibits, deposition of the plaintiff Syracuse, the art not cited by the United States Patent Office in the prosecution of the patent in suit, and the Points and Authorities submitted in support of said Motion; after considering the plaintiff's Brief in Reply to Defendant's Motion for Summary Judgment; after considering the Brief Amicus Curiae of Alan Franklin; and after hearing counsel for the respective parties, and upon due deliberation having been had and Findings of Fact and Conclusions of Law of the Court having been signed, [68]

It Is Ordered, that said Motion for Summary Judgment be and the same is hereby granted, and judgment is hereby entered herein in favor of the

defendant Harry Paris, dismissing this action, with costs and disbursements to be taxed by the Clerk in favor of defendant Harry Paris and against the plaintiffs.

Dated at Los Angeles, California, the 11th day of February, 1954.

/s/ ERNEST A. TOLIN,
Judge of the United States
District Court.

Approved as to form:

.....

HAROLD SHIRE,
Attorney for Plaintiffs.

Receipt of Copy acknowledged.

[Endorsed]: Filed February 11, 1955.

Docketed and entered February 15, 1955. [69]

[Title of District Court and Cause.]

NOTICE OF APPEAL

Notice is hereby given that Frances P. Syracuse and New Wonder Bag Corporation, a corporation, plaintiffs above named, hereby appeal to the United States Court of Appeals for the Ninth Circuit from the Summary Judgment entered in this action on February 15, 1955.

/s/ ALAN FRANKLIN,
Attorney for Appellants, Frances P. Syracuse and New Wonder Bag Corporation, a Corporation.

[Endorsed]: Filed March 11, 1955. [71]

[Title of District Court and Cause.]

ORDER EXTENDING TIME TO FILE RECORD AND DOCKET APPEAL

Good cause appearing therefor:

It Is Hereby Ordered that appellant may have to and including May 8, 1955, to file the record and docket the appeal in the above-entitled cause in the United States Court of Appeals for the Ninth Circuit.

Dated: Los Angeles, California, April 8, 1955.

/s/ BEN HARRISON,
U. S. District Judge.

[Endorsed]: Filed April 8, 1955. [72]

[Title of District Court and Cause.]

ORDER EXTENDING TIME TO FILE RECORD AND DOCKET APPEAL

Good cause appearing therefor:

It Is Hereby Ordered that appellant may have to and including June 11, 1955, to file the record and docket the appeal in the above-entitled cause in the United States Court of Appeals for the Ninth Circuit.

Dated: Los Angeles, California, May 5, 1955.

/s/ ERNEST A. TOLIN,
U. S. District Judge. [73]

[Title of District Court and Cause.]

AFFIDAVIT IN SUPPORT OF ORDER EXTENDING TIME TO FILE RECORD AND DOCKET APPEAL

State of California
County of Los Angeles—ss.

Alan Franklin, being first duly sworn deposes and says: I am the attorney for the plaintiffs in the above-entitled action. I was retained by the plaintiffs on the day of the hearing of the motion for summary judgment on too short notice to acquire a thorough knowledge of the facts of the case, and plaintiffs' attorney at the time, namely, Robert E. Geauque, evidently resenting my appearance in the case, withdrew from the case, and I have received no assistance whatever from him in preparing an appeal of this case, and, furthermore, I have never met plaintiffs' other attorney, Harold Shire, who, I am informed, is not a patent lawyer and I cannot expect any real help from him in this patent case. I did not solicit the [74] plaintiffs' case, in view of the fact that I have been so busy with other important legal matters. I was compelled to go to Washington, D. C., last month and argue a patent infringement suit against the U. S. Government, on April 4, 1955, in the Court of Claims, and that case, in which I was retained before I was retained in the present case, took up the greater part of my time last month, which prevented me for a substantial length of time from working alone on the appeal

of the present case. Recently I have found the case of Hycon Mfg. Co. v. H. Koch & Sons, 104 U.S.P.Q. 231 (CCA 9), which case involved a summary judgment and upholds the points and authorities of my Brief Amicus Curiae, which I filed in the present case, and particularly as to lack of jurisdiction of a trial court on motion for summary judgment in patent infringement suits on the issue of validity of a patent in suit, in view of the prior art, which issue necessarily involves technical questions of fact requiring a trial and the testimony of disinterested experts which was not present in the case at bar. The case of Hycon Mfg. Co. v. H. Koch & Sons, supra, holds as follows:

> "Utmost that can be said in patent validity case is that it is a mixed question of law and fact. * * *
>
> "The trial court exceeded the premissible limits of determination of disputed facts, questions without trial. * * * An indispensible prerequisite to such a summary judgment, is the absence of a material fact."

An important relevant fact in this case, which the Court did not have before it in rendering summary judgment, is the extraordinary commercial success of the plaintiffs' patent in suit. Counsel for plaintiffs, Geauque, asked the defendant, Paris, in his deposition, the extent of his business in selling [75] plaintiffs' patented handbag, but counsel for defendant objected to such questions and the witness

refused to answer proper relevant questions on advice of counsel, thereby suppressing valuable evidence. Unfortunately, the Paris deposition was not filed and an exhibit of the defendants' accused handbag is not in evidence. These and other matters are matters which I have just recently discovered and I need more time to study the same to prepare the plaintiffs' appeal.

/s/ ALAN FRANKLIN,
Attorney for Plaintiffs.

Subscribed and sworn to before me this 6th day of May, 1955.

[Seal] /s/ LOUISE LELAND,
Notary Public in and for
said County and State.

My Commission Expires Mar. 29, 1958.

[Endorsed]: Filed May 6, 1955. [76]

[Title of District Court and Cause.]

CASH COST BOND ON APPEAL

Know All Men by These Presents, that Frances P. Syracuse is held and firmly bound unto Harry Paris, defendant, in the above case, in the penal sum of Two Hundred Fifty and No/100 Dollars ($250.00), tendered herewith in cash, to be paid to said defendant, his successors, assigns or legal representatives, for which payment well and truly to be

made the said Frances P. Syracuse binds herself, her successors and assigns firmly by these presents.

The condition of the above Obligation is such that:

Whereas, Frances P. Syracuse and New Wonder Bag Corporation, a corporation organized and existing under the laws of the State of California, are about to take an appeal to the United States Court of Appeals for the Ninth Circuit from that certain summary judgment heretofore entered in this action on February 15, 1955, in favor of the defendant by the United States District Court for the Southern District of California, Central Division, in the above-entitled case.

Now, Therefore, if the above-named appellants shall prosecute said appeal to effect and answer all costs which may be adjudged against them if the appeal is dismissed, or the judgment affirmed, or such costs as the appellate court may award if the judgment is modified, then this obligation shall be void; otherwise to remain in full force and effect.

It Is Hereby Agreed by the Surety that in case of default or contumacy on the part of the surety, the Court may, upon notice to her of not less than ten days, proceed summarily and render judgment against her, in accordance with her obligation and award execution thereon.

Signed, sealed and dated this 19th day of May, 1955.

/s/ FRANCES P. SYRACUSE.

Examined and recommended for approval as provided in Rule 8.

/s/ ALAN FRANKLIN,
Attorney.

Duly verified.

[Endorsed]: Filed May 19, 1955.

[Title of District Court and Cause.]

CERTIFICATE OF CLERK

I, Jack A. Childress, Clerk of the United States District Court for the Southern District of California, do hereby certify that the foregoing pages numbered 1 to 88, inclusive, contain the original

Complaint;
Stipulation;
Amended Answer;
Motion for Summary Judgment;
Findings of Fact & Conclusions of Law;
Plaintiffs' Detailed Statement of Objections and Reasons;
Summary Judgment;
Notice of Appeal;
Order Extending Time to File Record to May 8, 1955;
Order Extending Time to File Record to June 11, 1955;
Statement of Points on Appeal;
Plaintiffs' Designation of Contents of Record on Appeal;

Defendant's Counter Designation of Additional Contents of Record;

which, together with Deposition of Frances P. Syracuse, taken on July 28, 1954, at Los Angeles, California, deft's exhibit C; File Wrapper and contents of the patent in suit; all in said cause,

constitute the transcript of record on appeal to the United States Court of Appeals for the Ninth Circuit.

I further certify that my fees for preparing and certifying the foregoing record amount to $1.60, which sum has been paid by appellant.

Witness my hand and the seal of said District Court, this 28th day of June, 1955.

[Seal] JOHN A. CHILDRESS,
Clerk.

By /s/ CHARLES E. JONES,
Deputy.

[Endorsed]: No. 14800. United States Court of Appeals for the Ninth Circuit. Frances P. Syracuse and New Wonder Bag Corporation, Appellants, vs. Harry Paris, Appellee. Transcript of Record. Appeal from the United States District Court for the Southern District of California, Central Division.

Filed June 29, 1955.

/s/ PAUL P. O'BRIEN,
Clerk of the United States Court of Appeals for the Ninth Circuit.

In the United States Court of Appeals
for the Ninth Circuit

No. 14800

FRANCES P. SYRACUSE and NEW WONDER BAG CORPORATION, a Corporation,

Plaintiffs,

vs.

HARRY PARIS, DOE I, et al,

Defendants.

STATEMENT OF POINTS ON APPEAL

Plaintiffs, Frances P. Syracuse and New Wonder Bag, now file the following Statement of Points asserted as errors and intended to be urged in the prosecution of their appeal from the Summary Judgment entered herein on or about February 15, 1955, and assert that the trial court erred in each of the following respects, to wit:

1. In rendering summary judgment for the defendant, Harry Paris.

2. In holding and adjudging that the single claim of Patent No. 2,533,850, issued December 12, 1950, is invalid and void.

3. In granting the defendants' motion for summary judgment in favor of the defendant, Harry Paris, and dismissing this action with costs and disbursements to be taxed by the Clerk in favor of defendant, Harry Paris, and against plaintiffs.

4. In failing to hold and adjudge that the single claim of Letters Patent No. 2,533,850 in suit, issued December 12, 1950, is good and valid in law.

5. In failing to hold and adjudge that the single claim of Patent No. 2,533,850, issued December 12, 1950, is infringed by the defendant, Harry Paris.

6. In failing to deny and dismiss the motion for summary judgment of the defendant, Harry Paris, with costs, disbursements and an attorney's fee taxed against said defendant in favor of plaintiffs.

7. The trial court exceeded the permissable limits of determination of disputed fact questions, without trial.

8. In holding and adjudging invalid the single claim of the utility patent No. 2,533,850 in suit of plaintiff, Frances P. Syracuse, issued December 12, 1950, in view of the design patent for bag to Shanzer, No. 147,477, issued September 9, 1947, which Shanzer patent fails to show the mechanical construction and functional features of the claim of said plaintiff's utility patent; and all elements of said Shanzer patent are in the public domain, except two bows at diagonal corners of one side of the Shanzer bag, which bows are not present in the structure or the invention of the plaintiff's said utility patent, as claimed by the claim of the plaintiff's patent in suit.

9. Finding 8 of the trial court that the Commissioner of Patents failed to cite against the applica-

tion for the patent in suit the most pertinent prior art is clearly an error. The presumption is that the Patent Office did its duty and considered the other patents brought forward, on motion for summary judgment, as new prior art. There is no evidence dehores these other patents, nor is there anything in the patents themselves which should overthrow the presumption that the Patent Office cited the best prior art against the application for the patent in suit.

10. In Finding 10 the trial court is clearly in error that the patent in suit does not disclose any patentable combination of elements, does not produce any novel results, or does not perform any new functions over the earlier design patent No. 147,477 to Shanzer. What function does the Shanzer design patent perform other than the function of ornamentation?—and the useful functions performed by the patent in suit cannot be anticipated by the ornamental function of the design patent of Shanzer or any other design patent. Design patents and utility patents are different, and independent legal entities, and are entirely noncognate. The questions of whether the patent in suit discloses any novel patentable combination or produces any novel results are questions of fact, over which the trial court had no jurisdiction on a motion for summary judgment.

11. The trial court is clearly in error in its Finding 11 that "Plaintiffs' patent is a combination patent and must be strictly construed, since practically all patents are combination patents including

primary patents, like the patent in suit, and primary patents are liberally construed."

12. Error of the trial court in Finding 12 that there is no discovery or patentable invention covered by the patent in suit within the meaning of the patent law.

13. Error of the trial court in Finding 13 that the patent in suit is fully anticipated by the prior art and involves only mechanical skill. Finding 13 involves a question of fact and is fatal to the defendants' motion for summary judgment.

14. Error of the trial court in Finding 14 that the claim of the patent in suit is devoid of any patentable novelty and is invalid, which finding involves a question of fact and defeats defendants' motion for summary judgment.

15. The Findings of Fact 8, 10, 11, 12, 13 and 14 all involve questions of fact, over which the trial court was without jurisdiction on motion for summary judgment.

16. Error of the trial court in rendering summary judgment for the defendant, Harry Paris, and thereby preventing a fair trial of the case on its real merits, at which trial plaintiffs were prepared to prove extraordinary commercial success of the handbag covered by the patent in suit, of which success the defendant, Harry Paris, has derived the entire benefit by his wilful and wanton infringement of the patent in suit, and by his unfair competition with the plaintiffs in the manufacture and